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10/659,229

09/10/2003

Tsuguo Kato

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EXAMINER

TSEGAYE, SABA

ART UNIT

PAPER NUMBER

2616

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/659,229

Applicant(s)

KATO ET AL.

Examiner

Saba Tsegaye

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 09/10/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figures 20-26 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities: Applicant is required to update the status of application Serial No. 09/482,712, cited on page 1 (cross-reference to related application), by indicating that it is now --US Patent number 6,646,999--.

Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 10-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,646,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 10-17 of the instant application merely broadens the scope of the claims 1-8 of the patent No. 6,646,999 by eliminating the elements and their functions of the claims. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by The Admitted Prior Art (figs. 2-26).

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The Admitted Prior art discloses (figs 20-23) a location registration server (20-4-1 to 20-4-3) for a use in a mobile packet communication system including mobile terminals (20-1-1; 20-1-2) connected via a mobile radio communication network, subscriber nodes (1-2-1 to 1-2-3) accommodating said mobile terminals (20-1-1; 20-1-2), and gate nodes (20-3-1; 20-3-2) connected to fixed equipment including Internet service providers or local area networks (20-5-1; 20-5-2), said location registration server being associated with a group of destination packet addresses having the same high-order digits (page 2, lines 16-23), wherein said subscriber nodes, said gate nodes, and said location registration server are interconnected by a network and are each assigned a unique packet address for routing (pages 2-8), said location registration server comprising:

a register which stores, for each mobile terminal assigned a packet address containing the high-order digit of packet destination address associated with said location registration server, the address of a subscriber node currently serving said each mobile terminal, or stores, for each fixed equipment assigned a packet address containing said high-order digit, the address of a gate node to which said each fixed equipment is connected (see fig. 20; page 3, lines 2-8);

means for retrieving, by reference to a destination packet address contained in a packet received from a transmitting node which is a subscriber node that received a packet from a particular mobile terminal or a gate node that received a packet from particular fixed equipment, the address of a mobile terminal corresponding to said destination address or the address of a receiving gate node connected to the fixed equipment corresponding to said destination address; and means for returning the retrieved receiving node address to said transmitting node (page 7, line 10-page 8, line 13).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over The Admitted Prior Art in view of Hartmaier et al. (US 6,393,269 B1).

The Admitted Prior Art discloses, in figs. 2-23, a subscriber node (1-2-1 to 1-2-3) for use in a mobile packet communication system comprising mobile terminals (20-1-1; 20-1-2) connected via a mobile radio communication network, gate nodes (20-3-1; 20-3,-2) connected to fixed equipment (20-5-1; 20-5-2) including Internet service providers or local area networks, and a plurality of location registration servers (20-4-1 to 20-4-3) each for a group of destination packet addresses having the same high-order digits (page 2, lines 16-23), wherein said subscriber node accommodates said mobile terminals, said subscriber node, said gate nodes, and said location registration servers are interconnected by a network, and said subscriber node, said gate nodes, and said location registration servers are each assigned a unique address for routing (page 2, lines 5-15), said subscriber node comprising:

means for receiving a packet from a particular accommodated mobile terminal (page 7, lines 7-9);

a table for retrieving the address of a corresponding location registration server by reference to the high-order digits of the packet destination address (page 7, lines 10-15);

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means for transferring said received packet to said corresponding location registration server (page 7, lines 16-20); and

means for receiving a receiving node address returned from said corresponding location registration server, retrieved by the corresponding location registration server with reference to a destination address contained in said received packet (page 7, line 21-page 8, line 4).

The Admitted Prior Art does not expressly disclose means for temporarily storing the receiving node address and means for transferring directly to the receiving node by using the temporarily stored receiving node address.

Hartmaier teaches in fig. 2, steps 207-209, that MSC sends a registration notification command (RegNot) to a HLR, step 205. The HLR responds the RegNot command with the parameter trigaddrlist (network address of the device associated with each trigger), step 207. In step 208 the MSC stores the received information in a temporary database, which is created just for the duration of this call (column 5, line 55-column 6, line 15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a system that temporarily stores the receiving node address, such as that suggested by Hartmaier, to the system of The Admitted Prior Art in order to increase efficiency.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakajima et al. (US 7,010,302 B1) discloses a packet transmission method on mobile communications network.

Buppelmann (US 6,556,831 B1) discloses a telecommunication system.

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Bantz et al. (US 5,519,706) discloses dynamic user registration method in a mobile communications network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saba Tsegaye whose telephone number is (571) 272-3091. The examiner can normally be reached on Monday-Friday (7:30-5:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ST  
May 11, 2007

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER

5/14/07